

REMARKS

Claims 22-24 and 26-29 are pending in the application. Claim 29 is newly presented. Reconsideration of this application is respectfully requested.

The Office Action rejects claims 22-24, 27 and 28 under 35 U.S.C 103(a) as unpatentable over U.S. Patent No. 5,963,199 to Kato et al., hereafter Kato, in view of U.S Patent No. 4,430,526 to Brown, hereafter Brown.

Independent claim 22 claims an input device that includes a memory, a controller having a first CPU and an electronic pen. The electronic pen is operative to emit a first signal having a first characteristic and a second signal having a second characteristic. Independent claim 22 further claims a detector that detects the emitted signals. The "first CPU selectively interprets the emitted signals as one of information to be stored by said input device and information to be forwarded to said computing device and that routes (a) to said memory the information to be stored therein and (b) to the computing device the information to be forwarded thereto for processing by said second CPU".

As described in the specification and shown in the drawings, the electronic pen has first and second tips. When the first pen tip is down, the first CPU stores handwriting in local memory. When the second pen tip is down, the first CPU sends the pen position information to a second CPU. The advantage is that handwriting can be either stored at very low power locally in the input device when the second CPU is off or the second pen tip can be used to control the second computer when it is on.

The rejection is erroneous. Neither Kato nor Brown discloses or teaches the above quoted passage of independent claim 22. Therefore, independent claim 22 cannot be obvious in view of any combination of Kato and Brown.

Both Kato and Brown describe systems where the pens are only used to update a high power second computer. Neither Kato nor Brown describe or teach a situation where the system could operate in a low power state, such as would occur when storing ink into a local (Flash) memory. While Kato might describe the use of a microcontroller in the tablet input device, Kato does not teach that the microcontroller makes a decision to store pen information locally or route it to another system.

The Examiner contends that the above quoted passage of Independent claim 22 is described in Kato at column 8, lines 1-47, and at column 9, lines 14-35. The column 8 citation describes the flow diagram of Fig. 6, which is stated at column 7, lines 63 and 64, to be a process executed by image processor 5. That is, image processor 5 executes the Fig. 6 process in response to the signals delivered by microcontroller 353 of the input device 3. This citation does not teach that microcontroller 353 interprets first and second signals of the input pen as one of storing the information locally or sending it to image processor 5 as claimed in independent claim 22. Rather, microcontroller 353 processes these signals and delivers them to image processor 5, column 8, lines 12 and 13. Microcontroller 353 only has the ability to process the pen signals and send them to image processor 5. There is no ability to interpret the pen signals as claimed in independent claim 22. Therefore, the column 8 citation provides no support for the Examiner's contention.

The column 9 citation merely describes the input units or pens 31 and does not describe the operation of microcontroller 353. Therefore, the column 9 citation provides no support for the Examiner's contention.

The advantage of the claimed invention becomes readily apparent when a pen that has two functions is considered. One function is leaving ink on a physical piece of paper while storing pen position to Flash in a low power mode, and the other function is to control a high power computer. This allows the input

device to be used when the associated higher power computing device is turned off, thereby conserving power.

For the reason set forth above, it is submitted that the rejection of claims 22-24, 27 and 28 under 35 U.S.C. 103(a) is erroneous and should be withdrawn.

The Office Action rejects claim 26 under 35 U.S.C 103(a) as unpatentable over Kato in view of Brown as applied to claim 22, and further in view of U.S Patent No. 6,417,844 to Kodama, hereafter Kodama.

This rejection is erroneous for the reason that independent claim 22, upon which claim 26 is dependent, is unobvious over the Kato and Brown combination for the reason set forth in the discussion of the rejection of independent claim 22.

Moreover, the Office Action suggestion to use Kodama in combination with Kato and Brown is improperly based on the hindsight of Applicants' disclosure. Such hindsight reconstruction of the art cannot be the basis of a rejection under 35 U.S.C. 103. The prior art itself must suggest that modification or provide the reason or motivation for making such modification. In re Laskowski, 871 F.2d 115, 117, 10 USPQ 2d 1397, 1398-1399 (CAFC, 1989). "The invention must be viewed not after the blueprint has been drawn by the inventor, but as it would have been perceived in the state of the art that existed at the time the invention was made." Sensonics Inc. v. Aerosonic Corp. 38 USPQ 2d 1551, 1554 (CAFC, 1996), citing Interconnect Planning Corp. v. Feil, 774 F. 2d 1132, 1138, 227 USPQ 543, 547 (CAFC, 1985).

In the case of claim 26, there is no suggestion in the prior art to make such a modification to Kato and Brown. Both Brown and Kato describe systems in which a display is updated in "real time". In both systems, for example, if a person moves a pen the image on the computer screen will be updated to reflect the result of the pen movement. In the case of Kato a pen movement may

change the color of a region on the screen, while in the case of Brown it might result in the user across a teleconference link seeing a pen stroke. Because both Kato and Brown dynamically display information, it would not make any sense to add the Flash memory described in Kodama, because their functions would just not work.

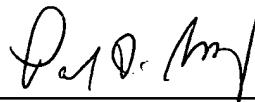
For the reasons set forth above, it is submitted that the rejection of claim 26 under 35 U.S.C. 103(a) is erroneous and should be withdrawn.

New claim 29 recites that the "first CPU interprets said first signal as information to be stored in said memory and the second signal as information to be forwarded to said second CPU". As pointed out in the discussion of the rejection of independent claim 22, upon which claim 29 is dependent, neither Kato nor Brown teaches this operation of the CPU in the input device. Accordingly, claim 29 should be allowable.

It is respectfully requested for the reasons set forth above that the rejections under 35 U.S.C. 103(a) be withdrawn, that claims 22-24 and 26-29 be allowed and that this application be passed to issue.

Respectfully Submitted,

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